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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,824	01/05/2004	Wolfgang Ebenbeck	CH-7990/LeA 36,508	3612

34947 7590 09/26/2005

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EXAMINER

DAVIS, BRIAN J

ART UNIT PAPER NUMBER

1621

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/751,824	Applicant(s) EBENBECK ET AL	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/2/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 7, 8 and 10 is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 9, 15, 16 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections Withdrawn

The various objections to claims 1-10, outlined in the previous Office Action, have been overcome by applicant's amendment. The amendment corrects the claims as appropriate.

Claim Objections Maintained

The objection to claim 6 because it does not end with a period is maintained.

Claim Objections, NEW

Claim 9 is objected to because of the following informalities: the □ that appears in the text of the claim should properly be replaced by the symbol α . Appropriate correction is required.

112 Rejections Withdrawn

The rejection of claims 11-17 under 35 USC 112, second paragraph, outlined in the previous Office Action, has been overcome by applicant's amendment. With respect to claims 13, 14 and 17, the amendment cancels the claims. With respect to the remaining claims, applicant's amendment and arguments have been carefully considered and are persuasive.

102 Rejections Withdrawn

The rejection of claims 1-5, 7 and 8 under 35 USC 102(b), outlined in the previous Office Action, has been overcome by applicant's amendment. The amendment narrows the claims such that difluorophosgene cannot be present except in a mixture with oxalyl fluoride.

Claim Rejections - 35 USC § 102, NEW

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *J. Fluorine Chem.* 1983, 23, p. 219-228, cited by applicant in the IDS and discussed in the specification.

As applicant makes explicitly clear on page 1 line 13 of the specification, it is well known in the art to use α,α -difluoroamines (and difluoromethylene- α,α -diazo compounds) as fluorinating agents for alcohols or carbonyl compounds (citing *J. Fluorine Chem.* 1983, 23, p. 219-228).

Allowable Subject Matter

Claims 1-5, 7, 8, 10 allowed. Claims 15, 16 and 18 are objected to as being dependent upon a base claim which has been objected to, but whose subject matter is otherwise allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
September 19, 2005